

DOCKET NO.: POLY-1194

PATENT

13. (Amended) The element of claim 12 wherein said polyurethane is an acid-modified acrylate polyurethane or an amine-modified acrylate polyurethane.

Please cancel claims 15 and 16.

### REMARKS

As a preliminary matter, Applicants wish to thank the Examiner for taking the time to meet with their counsel on May 9, 2002, to discuss the outstanding Office Action.

Claims 10 to 18 are pending in the present application. Claims 10 and 13 have been amended herein, claims 15 and 16 have been canceled, and no new claims have been added.

In view of the following remarks, Applicants respectfully request withdrawal of the rejections.

#### I. The Specification Describes the Claimed Subject Matter

Claims 10 to 18 have been rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate written description because the specification allegedly does not describe an ablation layer ablatable by infrared radiation. Applicants traverse the rejection because the specification clearly demonstrates that Applicants were in possession of this subject matter at the time of filing.

A patent application need not describe a claimed invention in *ipsis verbis* to comply with the written description requirement. "[A]ll that is required is that it reasonably

DOCKET NO.: POLY-1194

PATENT

convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him.” *In re Edwards*, 568 F.2d 1349, 1351-1352 (C.C.P.A. 1978)(citations omitted). To determine whether a specification contains adequate written description of the claimed subject matter, the critical question, therefore, is not whether literal description of the claimed subject matter is present in the specification, but, rather, whether review of the specification would convey the claimed subject matter to those having skill in the art. *Id.*

Adequate written description is provided if a skilled artisan, upon review of a patent specification in light of the properties and features of what is described, would envision the claimed subject matter. *In re Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973). In *Smythe*, the original specification and claims described a segmentation medium as air or other gas. Claims directed to fluid as the segmentation medium were later introduced into the application. The Court of Customs and Patent Appeals held that adequate written description of fluid as the segmentation medium existed in the specification because the essential properties and features of the segmentation medium, as described in the specification, defined a fluid. *Id.* at 1384. The court found that upon review of the specification at the time of the invention, one of ordinary skill in the art would have realized that Applicants were in possession of fluid as a segmentation medium. As the court observed, because the broader concept of using “inert fluid” would naturally occur to one skilled in the art from reading appellants’ description, there was “no basis for denying appellants the claims which recite the segmentizing medium broadly as an ‘inert fluid.’” *Id.* at 1384.

**DOCKET NO.: POLY-1194****PATENT**

The same logic mandates a finding that Applicants' claims are adequately described, because the instant specification describes a photosensitive element comprising an ablation layer that is ablatable by infrared radiation. For example, Example 3 describes ablation of a layer of a photosensitive element by a laser operating at a wavelength in the infrared region, *i.e.*, 10.6  $\mu\text{m}$ , and tests conducted using a laser at another infrared wavelength, *i.e.*, 1.06  $\mu\text{m}$  (*see* page 17, line 27 to page 29, line 9 of the specification). The skilled artisan reading this would have recognized that Applicants invention encompassed ablation in the infrared wavelength region.

Although the Office Action asserts that "the only support for a layer that could be ablatable by infrared laser is that in Example 3 specific to a polyamide" (Office Action dated January 16, 2002, pages 3 to 4), the specification describes numerous binders, other than polyamide, that can be included in the ablation layer. For example, polyacetal, polyacrylic, polyimide, polybutylene, polycarbonate, polyester, polyethylene, polyphenylene ether, and polyethylene oxide binders are described in the specification. (Page 10, lines 4 to 7). Based upon this description of numerous binders, and the experiments described in Example 3 in which an ablation layer containing one of them was used, the skilled artisan would have realized that Applicants were in possession of infrared ablation layers containing binders other than polyamide, and that Example 3 merely exemplifies the use of one of numerous possible binders.

The specification also contains adequate written description of an ablation layer that is opaque to non-infrared actinic radiation. Although the Office Action asserts that "'non-infrared actinic radiation' is not fully supported by the original disclosure and claims"

**DOCKET NO.: POLY-1194****PATENT**

(Office Action dated January 16, 2002, page 3), the specification clearly describes ablation layers that are opaque to ultraviolet radiation (*see, e.g.*, page 8, lines 1 to 7 of the specification). It is undisputed, for example, that the specification describes ablation layers that are opaque to ultraviolet light (*see, e.g.*, page 8, lines 1 to 11). Indeed, this is the primary reason that ablation layers are employed. Because those skilled in the art are aware that ultraviolet radiation is non-infrared actinic radiation, it would have been clear to a skilled artisan reading Applicants' specification that an ablation layer that is opaque to ultraviolet radiation necessarily would also be opaque to non-infrared actinic radiation. One of skill in the art would therefore have realized that Applicants were in possession of an ablation layer that is opaque to non-infrared actinic radiation, and written description support therefore exists in the specification for this subject matter.

Because the specification contains adequate written description of a photosensitive element comprising an ablation layer that is ablatable by infrared radiation and opaque to non-infrared actinic radiation, Applicants request withdrawal of the rejection.

The Office Action also asserts that no support exists in the specification for a photopolymerizable layer containing a mixture of the materials recited in claims 12 and 13. (Office Action dated January 16, 2002, page 4). Without conceding the correctness of the assertion, and to further clarify the subject matter that Applicants regard as their invention, claim 13 has been amended to recite that the polyurethane of claim 12 is an acid-modified acrylate polyurethane or an amine-modified acrylate polyurethane. Support for the amendment is found in the specification at, for example, page 10, lines 20 to 29.

**DOCKET NO.: POLY-1194****PATENT**

The Office Action further asserts that no support exists in the specification for an infrared ablatable layer with a hydroxypropylcellulose binder. (Office Action dated January 16, 2002, page 4). Without conceding the correctness of the assertion, and to advance prosecution, claim 15 has been canceled. Applicants accordingly request withdrawal of the rejection.

## **II. The Scott Paper Patent Does Not Anticipate the Claims**

Preliminarily, to further clarify the subject matter that Applicants regard as their invention, claim 10 has been amended to recite that the infrared ablation layer comprises at least one binder that is a polyacetal, polyacrylic, polyamide, polyimide, polybutylene, polycarbonate, polyester, polyethylene, polyphenylene ether, or polyethylene oxide. Claims 15 and 16 have been canceled. Support for the amendments is found in the specification at, for example, page 10, lines 3 to 7.

Claims 10, 14 to 15, 17, and 18 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Great Britain Patent No. 1,492,070 (hereinafter "the Scott Paper patent"). Applicants request reconsideration and withdrawal of the rejection because the Scott Paper patent fails to disclose or suggest every claim element. The patent, for example, describes printing plates that contain a dispersion of metal or carbon particles in a nitrocellulose binder. Since nitrocellulose binders are different from those claimed, and since the patent fails to disclose or suggest binders other than nitrocellulose, the patent fails to disclose or suggest any claimed invention. *Atlas Powder Co. v. E.I. Du Pont de Nemours &*

**DOCKET NO.: POLY-1194****PATENT**

*Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984) (holding of no anticipation affirmed because reference failed to disclose or suggest all claim elements).

### **III. The Fan Patent Does Not Anticipate the Claims**

Claims 10 to 12 and 14 to 18 have been rejected under 35 U.S.C. § 102(a) or (e) as allegedly anticipated by U.S. Patent No. 6,238,837 (hereinafter "the Fan patent"), as further evidenced by U.S. Patent No. 4,045,231 ("hereinafter the Toda patent"), U.S. Patent No. 4,430,417 (hereinafter "the Heinz patent"), and U.S. Patent No. 4,323,636 (hereinafter "the Chen patent"). Applicants respectfully traverse the rejection because these claims are entitled to a filing date that is early enough that the Fan patent is not available as prior art.

The Office Action mistakenly suggests that support for claims 10 to 18 is not found in priority application number 08/082,689, filed June 25, 1993, and that the Fan patent is therefore somehow available as prior art against the claims. As discussed in part I of this Response, however, the present specification provides support for claims 10 to 18. Since the supporting disclosure appears nearly verbatim in application number 08/082,689, the claims are entitled to the benefit of the June 25, 1993 filing date of that patent application. Because this date is more than twenty-two months before the earliest filing date to which the Fan patent purports to be entitled, the Fan patent is not prior art against the present claims. Accordingly, the rejection for alleged anticipation is improper, and should be withdrawn.

DOCKET NO.: POLY-1194

PATENT

**C nclusion**

Applicants submit that the claims are in condition for allowance, and an early Office Action to that effect is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

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Jane E. Inglese  
Jane E. Inglese, Ph.D.  
Registration No. 48,444

WOODCOCK WASHBURN LLP  
One Liberty Place - 46th Floor  
Philadelphia, PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439

**DOCKET NO.: POLY-1194****PATENT****VERSION WITH MARKINGS TO SHOW CHANGES MADE****In the Specification:**

Please delete the paragraph beginning at line 1 of page 17 and ending at line 10 of page 17 and replace it with the following new paragraph.

**Example 2**

**Preparation of Uvinul D 50 modified Cellulosic-Based  
Water-Wash [Blip] Slip Film for Amine-Modified Polyurethane  
(AMPU) Aqueous-Developable Flexographic Plates**

In this Example, another type of slip film, a cellulose film adapted for use with a water-washable flexographic printing plate, is modified with a UV absorber. The concentration and thickness found in the previous Example were utilized to ensure the maximum UV absorption by the film.

**In the Claims:**

Please amend claims 10 and 13 as follows.

10. (Amended) A photosensitive element comprising:

- a backing layer;
- at least one layer of photopolymerizable material on said backing layer;
- at least one ablation layer which is ablatable by infrared radiation and

opaque to non-infrared actinic radiation, wherein the infrared ablation layer is in direct contact with the at least one photopolymerizable layer and has a surface opposite the



DOCKET NO.: POLY-1194

PATENT

photopolymerizable layer capable of being exposed to laser ablation, the infrared ablation layer comprising:

- at least one infrared absorbing material; and
- at least one binder that is a polyacetal, polyacrylic, polyimide, polybutylene, polycarbonate, polyester, polyethylene, [cellulosic polymer,] polyphenylene ether, or polyethylene oxide;

wherein the ablation layer is ablatable from the surface of the photopolymerizable layer upon exposure to infrared laser radiation.

13. (Amended) The element of claim 12 wherein said [photopolymerizable layer includes an] polyurethane is an acid-modified acrylate polyurethane or an amine-modified acrylate polyurethane.

Claims 15 and 16 have been canceled.